

ITAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN  
CALIFORNIA,

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 125,615

Serial No. 75/358,031

Mark: SC (Stylized)

Filed: September 16, 1997

Published: May 18, 1999



10-22-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

**OPPOSER'S OPPOSITION TO MOTION TO COMPEL**

**A. The Motion Is Unnecessary to the Extent Applicant Seeks to Demonstrate Its Diligence Under F.R.C.P. 56(f) Because Opposer Will Not Challenge That Diligence**

This motion was filed while discovery was suspended. [Applicant's Motion at 1.] It was also filed without conferring with opposing counsel, apparently solely in order to get the motion on file before the anticipated summary judgment motion from Opposer University of Southern California ("California"). [Declaration of Michael S. Adler ("Adler Decl.") ¶¶ 4-8.] This motion is entirely unnecessary because it will not affect this Board's consideration on the summary judgment motion.

This issue arises following this Board's Order summarily adjudicating against the counter-claim of Applicant University of South Carolina ("Carolina"). After that ruling, the parties agreed to stay discovery through and including October 15 in order to focus on settlement. [Stipulated Motion Regarding Discovery and Other Dates, attached as Adler Decl. Ex. A.] The parties understood that California would file a summary judgment motion on or about October 15, 2003 in the absence of any settlement. [Adler Decl. ¶¶ 4, 6.] Settlement talks have not been productive, and California confirmed to Carolina that California would be going forward with its summary judgment motion. [Adler Decl. ¶ 6.]

The only possible purpose of filing this motion during the discovery stay would be to provide a possible support for the invocation of F.R.C.P. 56(f) in connection with California's summary judgment motion. Carolina apparently wants to make a record of its diligence in discovery. If so, this motion is unnecessary because California will not challenge Carolina's diligence.

Put differently, although California believes that Carolina's discovery should be reformulated in light of the dismissal of Carolina's counter-claims, [Adler Decl. ¶ 10.], California

will not dispute that Carolina sought certain discovery. Nor will California dispute that Carolina has pursued such discovery diligently. California *would* oppose any F.R.C.P. 56(f) claim on the basis that such discovery is irrelevant to the summary judgment motion, but that question is not implicated in this motion. For this motion, California will only note that Carolina's discovery was timely served and that *if* Carolina otherwise could satisfy F.R.C.P. 56(f), California would not challenge Carolina's diligence in relying on that discovery under F.R.C.P. 56(f).

**B. The Motion Is Procedurally Improper to the Extent that Applicant Seeks an Actual Order Compelling Discovery**

Although Applicant purports to seek an immediate response to its outstanding discovery, the motion would be premature for any number of reasons.

First, as noted above, the motion was filed during a stay of discovery. [Adler Dec. ¶ 4 and Ex. A thereto.]

Second, as noted above, the motion was filed without any conference of parties. [*Id.* ¶ 8.] 37 CFR § 2.120(e) requires a moving party to submit a written statement that a good faith effort was made, by conference or correspondence, to resolve the issue, and that the parties have been unable to reach agreement. No such statement was submitted because no good faith effort was made. *See also MacMillan Bloedel Ltd. v. Arrow-M Corp.* 203 USPQ 952, 954 (TTAB 1979) (a statement that discovery has not been responded to is an insufficient basis for a motion to compel).

Third, as noted above, California understood that the discovery was moot. [*Id.* ¶ 10 and Ex. B.]

Fourth, even if the discovery had not been moot, the discovery had been stayed first by agreement of the parties, second California's successful motion to dismiss Carolina's counter-

claim, third by yet another agreement of the parties, and finally by the filing of California's current summary judgment motion. [*Id.* ¶¶ 12-13.] As such, even if the discovery were still pending, it could never have become overdue because it has never become due. To the extent that it is not moot, the discovery is simply pending and need not be addressed by either party until the resolution of the current summary judgment motion.

In short, this motion is procedurally improper and must be denied. California believes this case will be resolved by its currently pending summary judgment motion. In the event that California is mistaken, California will respond to any appropriate discovery. For the time being, however, the relevant issue before this Board is California's motion for summary judgment and this motion is both improper and irrelevant and should be denied.

### C. CONCLUSION

For the reasons discussed above, this motion should be denied.

Dated: October 22, 2003

Respectfully submitted,

GIBSON DUNN & CRUTCHER, LLP



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University of Southern California

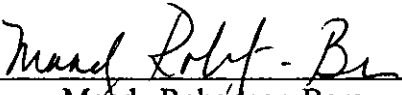
Reference no. 93107-00125

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S OPPOSITION TO MOTION TO COMPEL** is being placed in the United States mail, first class, postage pre-paid, addressed to the following on this 22nd day of October, 2003.

John C. McElwaine  
Matthew D. Patterson  
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Liberty Building, Suite 500  
Charleston, South Carolina 29401


Attorneys for Applicant University of South Carolina

  
Mandy Robertson-Bora

**CERTIFICATE OF EXPRESS MAILING UNDER 37 § CFR 1.10**

I hereby certify that on October 15, 2003, the attached **OPPOSER'S OPPOSITION TO MOTION TO COMPEL** (re Opposition No. 125,615) is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to:

BOX TTAB – NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202

  
Mandy Robertson-Bora

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Express Mail Label Number

Enc. Postcard receipt  
Reference no. 93107-00125

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**DECLARATION OF MICHAEL S. ADLER IN SUPPORT OF**

**OPPOSER'S OPPOSITION TO MOTION TO COMPEL**

I, Michael S. Adler, declare:

1. I am an attorney with the law firm of Gibson, Dunn & Crutcher, LLP, counsel of record in this matter for Opposer the University of Southern California ("California"). To the extent that facts herein are not a matter of record in the United States Patent and Trademark Office, I have personal knowledge of the facts set forth in this declaration and, if called as a witness, I could and would competently testify thereto.

2. On or about October 28, 2002, California filed a motion to dismiss the counter-claims of Applicant University of South Carolina ("Carolina.") That motion was subsequently converted into a motion for summary adjudication by this Board by Order dated February 10, 2003.

3. On or about July 31, 2003, this Board dismissed Carolina's counter-claims.

4. Subsequent to that dismissal, the parties re-entered into settlement negotiations. The parties also agreed to enter a stay of discovery until October 15, 2003 to facilitate such settlement negotiations. Attached hereto as Exhibit A is a true and correct copy of the stipulated motion filed with this Board.

5. As reflected in that motion, the parties discussed the intention of California to file a summary judgment motion in the event that settlement discussions were unsuccessful.

6. By the end of September, little progress had been made on settlement negotiations, and I reminded counsel for Carolina that California would bring its summary judgment motion on or about October 15, 2003 unless the parties appeared close to settlement.

7. There was no substantive settlement communication between that communication and October 15. Consequently, California filed its motion for summary judgment on October 15, 2003.

8. Not only was there no settlement communication, there was no discussion of discovery or of any potential motion to compel during the period of the discovery stay. This motion, which was apparently filed on October 14, 2003 during the discovery stay, comes as a complete surprise to us. There was no meet and confer before bringing this motion.

9. Moreover, we understood that the discovery involved was either moot or, at worst, not yet due, given the fact that this discovery was served shortly before California's original motion to dismiss Carolina's counter-claim.

10. In particular, I explained to counsel for Carolina that we believed the matter was moot in December of last year, when I wrote a letter discussing the fact that the discovery would need to be reformulated as a result of any ruling by this Board. A true and correct copy of that letter is attached hereto as Exhibit B.

11. I never received any response to that letter indicating that Carolina held any other view.

12. Moreover, even if Carolina still believed that the discovery was pending, that discovery has never come due. Although originally served on or about July 29, 2002, the return date for the discovery was extended by a series of stipulations between the parties while the parties discussed settlement. At least one of those extensions was confirmed in writing on or about August 28, 2002, a true and correct copy of which is attached hereto as Exhibit C. Another extension is referenced in a September 5, 2003 email from Carolina's counsel to me, a true and correct copy of which is attached hereto as Exhibit D.


13. Those extensions continued until California filed its motion to dismiss Carolina's counter-claim, on or about October 28, 2002. Discovery was then stayed as a result of California's successful motion to dismiss, and after that by the stipulation of the parties through



October 15, 2003, and finally now as a result of California's filing of its current motion for summary judgment.

I declare that this declaration is true and correct under penalty of perjury of the laws of the United States.

Executed this 21st day of October in Los Angeles, California.



Michael S. Adler

Reference no. 93107-00125



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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN  
CALIFORNIA,

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 125,615

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UNIVERSITY OF SOUTH CAROLINA,

Petitioner,

v.

UNIVERSITY OF SOUTHERN  
CALIFORNIA,

Respondent.

Opposition No. 125,615

Reg. No. 1,844,953

Mark: SC (Word Mark)

Registered: July 12, 1994



10-22-2003

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #78

**STIPULATED MOTION REGARDING DISCOVERY AND OTHER DATES**

WHEREAS, Opposer University of Southern California ("California") filed a motion to dismiss the counter-claim of Applicant University of South Carolina ("Carolina"), and

WHEREAS, the Board subsequently converted that motion into a motion for summary judgment and granted that motion; and

WHEREAS, following that Order by the Board, California has informed Carolina that California expects to bring a summary adjudication motion on Carolina's Application; and

WHEREAS, during the course of that conversation, the parties have discussed possible formulas to settle this litigation, and

WHEREAS, the parties have agreed to attempt to settle this matter during the month of September, 2003, and

WHEREAS, should the parties not settle this matter by the end of September, California expects draft and file a motion for summary judgment by October 15, 2003, and

WHEREAS, the parties have agreed that it would be counter-productive to expend time and resources on discovery when the matter may be resolved by settlement and/or summary judgment,

THEREFORE, the parties have agreed and California hereby moves to suspend discovery through and until October 15, 2003, and the parties have further agreed and California hereby moves for an Order approving the following discovery schedule in the event that California does not file its summary judgment motion by October 15, 2003:

The Period for Discovery to Close:	January 30, 2004
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Testimony Period for Party in Position of plaintiff to Close (opening thirty days prior thereto)	April 30, 2004
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Testimony Period for Party in Position of defendant to Close (opening thirty days prior thereto)	July 30, 2004
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Rebuttal testimony period to close  
(opening thirty days prior thereto)

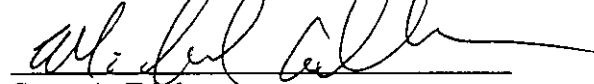
September 10, 2004

Applicant University of South Carolina has consented to this stipulation regarding discovery and other dates.

Dated: September 5, 2003

Respectfully submitted,

GIBSON, DUNN & CRUTCHER, LLP



Scott A. Edelman

Michael S. Adler

2029 Century Park East, Suite 4000

Los Angeles, CA 90067-3026

Telephone: (310) 552-8500

Attorneys for Opposer

University of Southern California

Reference no. 93107-00125

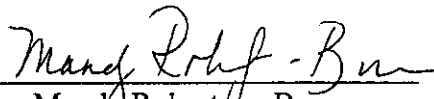
Opposition No. 125,615

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **STIPULATED MOTION REGARDING DISCOVERY AND OTHER DATES** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 5th day of September, 2003.

John C. McElwaine  
Matthew D. Patterson  
Nelson Mullins Riley & Scarborough, L.L.P.  
Liberty Building, Suite 500  
Charleston, South Carolina 29401

Attorneys for Applicant University of South Carolina

  
Mandy Robertson-Bora

**CERTIFICATE OF EXPRESS MAILING UNDER 37 § CFR 1.10**

I hereby certify that on September 5, 2003, the attached **STIPULATED MOTION REGARDING DISCOVERY AND OTHER DATES** (re Opposition No. 125,615) is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to:

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Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202

  
Mandy Robertson-Bora

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Enc. Postcard receipt  
Reference no. 93107-00125



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December 16, 2002

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*comfy*

### VIA FACSIMILE AND U.S. MAIL

John C. McElwaine  
Nelson, Mullins, Riley & Scarborough, L.L.P.  
P.O. Box 1806  
Charleston, SC 29402

Re: *TTAB Opposition 125,615* (University of Southern California v.  
University of South Carolina)

Dear John:

This letter will respond to your letter of December 10, 2002 regarding the outstanding discovery from the University of Southern Carolina.

Pursuant to 37 C.F.R. 2.127(d), the Board will normally suspend proceedings in an action when a motion to dismiss has been filed. I believe we discussed that issue previously, when I explained why California had chosen not to serve on you discovery that we had drafted.

We have now received an Order from the Board dated December 11, 2002, suspending proceedings in this action in light of the motion to dismiss.

Under the circumstances, we consider the discovery previously served to be moot. After the TTAB rules on the motion to dismiss, the parties can then formulate whatever discovery is appropriate in light of the disposition of that motion and California will of course respond to any appropriate discovery at that point.

As for your invitation to communicate with you to further settlement, California remains committed to its position that it would very much like to settle this matter as part of a global settlement which regulates any future use of the letters "SC" by the parties for product merchandising. In that respect, we have formulated a specific proposal and provided it to you,

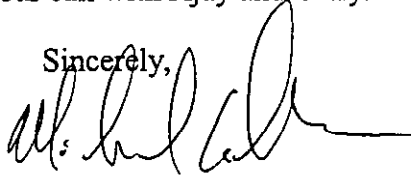


GIBSON, DUNN & C. LUTCHER LLP

John C. McElwaine  
December 16, 2002  
Page 2

and I understood from our call with Ajay and Terry that the ball is in your court. We would be interested in reviewing a counter-proposal from the University of South Carolina which addressed the points that we identified in our call with Ajay and Terry.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael S. Adler", with a long horizontal flourish extending to the right.

Michael S. Adler

MSA/mp



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August 28, 2002

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*Comes*

**VIA FACSIMILE**

John C. McElwaine  
Nelson, Mullins, Riley & Scarborough, L.L.P.  
P.O. Box 1806  
Charleston, SC 29402

Re: *TTAB Opposition 125,615* (University of Southern California v.  
University of South Carolina)

Dear Mr. McElwaine:

I am writing to confirm our earlier telephone conversation, in which you kindly agreed to extend the due date for discovery previously served on the University of Southern California ("California"). Per our conversation, this will confirm that California's responses to the currently-outstanding discovery is now due on September 19, 2002.

We also discussed the fact that California had previously drafted discovery to be served on the University of South Carolina ("Carolina"), but that California was withholding service until after the conference of parties scheduled for September 5, 2002. Of course, if the September 5 conference does not resolve the matter, California will serve that discovery.

I appreciate your cooperation.

Sincerely,



Michael S. Adler

MSA/msa



**Adler, Michael S.**

---

**From:** John McElwaine [JCM@nmrs.com]  
**Sent:** Thursday, September 05, 2002 11:43 AM  
**To:** 'Adler, Michael S.'  
**Subject:** RE: Agenda for a call tomorrow between U. of Southern California and U. of South Carolina

Michael,

The emergency that has cropped up is related to some NCAA allegations regarding our football program. Terry informs me that he is going to be tied up until at least Monday.

We apologize for the delay and will give you some dates early next week. We'll also bump back the discovery dates accordingly.

- John

-----Original Message-----

**From:** Adler, Michael S. [mailto:MAder@gibsondunn.com]  
**Sent:** Thursday, September 05, 2002 10:58 AM  
**To:** John McElwaine  
**Subject:** RE: Agenda for a call tomorrow between U. of Southern California and U. of South Carolina

John:

I will check with my client, but I am reasonably confident that he wanted to have a discussion principally between inside counsel with outside counsel present only to fill in background. Will Terry be available tomorrow?

-----Original Message-----

**From:** John McElwaine <JCM@nmrs.com>  
**Subject:** RE: Agenda for a call tomorrow between U. of Southern California and U. of South Carolina

Michael,

Terry cannot attend today because of an emergency. He has requested that the meeting go forward. I am available anytime after 1:30 EDT.

- John

-----Original Message-----

**From:** Adler, Michael S. [mailto:MAder@gibsondunn.com]  
**Sent:** Wednesday, September 04, 2002 3:07 PM  
**To:** John McElwaine  
**Subject:** Agenda for a call tomorrow between U. of Southern California and U. of South Carolina  
**Importance:** High

John:

Ajay indicated that he wanted us to have an agenda, and he asked us to send along our half of the proposed agenda for the call. I've got to run out to a meeting, but I'll give you a buzz when I get back to see what time works for the call tomorrow.

M.

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This message may contain confidential and privileged information. If it has been sent to you in error, please reply to advise the sender of the error and then immediately delete this message.

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Opposition No. 125,615

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John C. McElwaine  
Matthew D. Patterson  
Nelson Mullins Riley & Scarborough, L.L.P.  
Liberty Building, Suite 500  
Charleston, South Carolina 29401


Attorneys for Applicant University of South Carolina

  
Mandy Robertson-Bora

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